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OFFICE OF PETITIONS

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In re Patent No. 7,606,366	: DECISION ON REQUEST
Issued: October 20, 2009	: FOR RECONSIDERATION
Application No. 10/763,288	: OF PATENT TERM ADJUSTMENT
Filed: January 26, 2004	: AND
Attorney Docket No. 093196-0975	: NOTICE OF INTENT TO ISSUE
	: CERTIFICATE OF CORRECTION

This is a decision on the REQUEST FOR RECONSIDERATION OF DISMISSAL OF REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705 filed on November 13, 2009, requesting that the patent term adjustment be corrected from 652 to 1025 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).¹

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by six hundred five days is **GRANTED to the extent indicated herein**.

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on January 26, 2007 and ends on September 21, 2008, the day before the RCE was filed, and the B delay therefore is 604 days. See 35 U.S.C. 154(b)(1)(B)(i). Further, patentee fails to account for the filing of a Notice of Appeal on April 28, 2008. The 147 days of the over three year period consumed by appellate review, beginning on April 27, 2008 and ending on September 21, 2009 the date the RCE was filed, are not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii).

Additionally, Patentees renew there argument that the total Examination delay should be increased by 272 days. Patentees argue that an amendment was filed August 15, 2005 in response to a non- Final Office Action mailed July 5, 2005. A Final office action was then mailed November 3, 2005. However, in an Interview on December 20, 2005, the Examiner of record agreed to lift the finality of the November 3, 2005 Office Action and issue a new Action applying new art confirmed by an Interview Summary dated March 3, 2006. On September 13, 2006 a non-Final Office Action was mailed. Applicants argue further an entitlement to an additional 272 days of PTA pursuant to 37

¹Reconsidered in light of the Court of Appeals for the Federal Circuit's decision in Wyeth v. Kappos, 2009-1120 (Fed. Cir. 1-7-2010).

CFR 1.702(a)(2) due to inaction by the PTO from December 15, 2005 (4 months after the August 15, 2005 response to office action filed by Applicant) until the mailing of the second non-Final office action on September 13, 2006.

As indicated in the previous decision, patentees argument is not persuasive. 37 CFR 1.702(a)(2) provides that: Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken.

In this instance, the Office action mailed November 3, 2005 was mailed in response to and within four months of receipt of applicant's response filed August 15, 2005. The Office did not fail to take action in response to applicant's response within the time provided for in 37 CFR 1.702(a)(2). The fact that the Office subsequently mailed a further Office action withdrawing the finality of the November 3, 2005 Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(2) on November 3, 2005. Accordingly, patentees argument has been reconsidered but entry of an additional period of adjustment of 272 days for examination delay pursuant to 37 CFR 1.702(a)(2) is not warranted.

As such, the patent term adjustment is 605 days (176 "A delay" days plus 604 "B delay" days minus 147 days consumed by Appellate Review minus 28 days for applicant delay).

The Office acknowledges the authorization to charge the \$200.00 fee set forth in 37 CFR 1.18(e) to deposit account no. 19-0741.

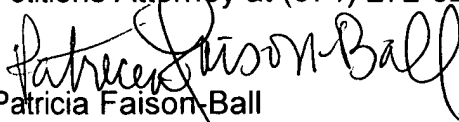
The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating

that the term of the above-identified patent is extended or adjusted by **six hundred five (605) days**.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.


Patricia Faison Ball
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT
UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,606,366 B2

DATED : October 20, 2009

INVENTOR(S) : Rade Petrovic

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (652) days

Delete the phrase “by 652 days” and insert – by 605 days--